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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,846	10/23/2003	Winfried Reich	A-876 .com/kys	5386

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Hoffman, Wasson & Gitler, P.C.
Suite 522
2361 Jefferson Davis Highway
Arlington, VA 22202

EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/690,846	Applicant(s) REICH ET AL.	
	Examiner Gregory J. Strimbu	Art Unit 3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006 and 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-22, 26, 27 and 30 is/are pending in the application.
- 4a) Of the above claim(s) 26, 27 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicant's election without traverse of Group II in the reply filed on November 7, 2005 is acknowledged. Accordingly, claims 26, 27 and 30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 7, 2006.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to because Figure 8 shows two different embodiments of the invention. Therefore, figure 8 should be listed as two separate figures for example, figure 8a and 8b. The drawings are objected to because they fail to use the proper cross sectional shading when showing the invention in cross section. For example, see figures 8 and 9. In figure 10, the section lines "I-I", "II-II" and "III-III" should be changed to --11-11--, --12-12-- and --13-13--, respectively, so that the section

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line indicates which figure shows the view taken from the section line. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because "[t]he invention pertains" and "a new type" on line 1 can be easily implied and therefore should be deleted.

Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: it appears that recitations such as "th Inv nti n" on line 1 of page 1 are a typographical errors. On line 2 of paragraph 23, it is suggested the applicant change "I-I" to --11-11-- to agree with the drawing changes. On line 2 of paragraph 24, it is suggested the applicant change "II-II" to --12-12-- to agree with the drawing changes. On line 2 of paragraph 25, it is suggested the applicant change "III-III" to --13-13-- to agree with the drawing changes. It is suggested that the applicant avoid using different language to refer to the same element of the invention. For example, the applicant should avoid referring to element 5 as "the lifting gear" on line 3 of paragraph 28 and as "the gear unit" on line 5 of paragraph 28. Also see element 16 in paragraphs 32 and 45 and element 22.1 in paragraph 36. Finally, the specification is objected to because it is unclear what "which in the running shoe . . . transmission 7" on lines 8-9 of paragraph 45 is attempting to set forth.

Appropriate correction is required.

Claim Objections

Claim 22 is objected to because it fails to list the claim number from which it depends. For purposes of this Office action claim 22 has been assumed to depend from claim 20. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 3-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with 35 USC 112 informalities. The applicant is requested to review and amend the claims to bring them into conformance with 35 USC 112, second paragraph, in light of the examples listed below.

Recitations such as “or” on line 1 of claim 3 render the claims indefinite because it is unclear which one of the two non-equivalent alternatives the applicant is attempting to positively set forth. Recitations such as “with at least one forend rail” on line 2 of claim 3 render the claims indefinite because it is not readily apparent if the fitting comprises the forend rail or if the fitting is merely intended to be used with the forend rail. Recitations such as “rod” on line 2 of claim 3 are confusing since it appears that the element 6 does not comprise a rod, but rather comprises a bar-type structure as shown in figure 6. Recitations such as “the area” on line 4 of claim 3 and “the drive body” on line 7 of claim 3 render the claims indefinite because they lack antecedent basis. Recitations such as “strip-shaped” on lines 5-6 of claim 3 render the claims

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indefinite because it is unclear what shape comprises a strip shape. Recitations such as “the forend rail form edge areas” on lines 7-8 of claim 3 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Recitations such as “a contact surfaces” on lines 8-9 of claim 3 render the claims indefinite because they are grammatically incorrect and confusing. Recitations such as “a casement frame element” on line 10 of claim 3 render the claims indefinite because it is unclear if the applicant is referring to the casement frame element set forth above or is attempting to set forth another casement frame element in addition to the one set forth above. Pronouns such as “it” on line 3 of claim 4 should be replaced with the element of the invention to which the pronoun refers. Recitations such as “the door or window casement” on lines 5-6 of claim 4 render the claims indefinite because they lack antecedent basis. Recitations such as “and with” on line 6 of claim 4 render the claims indefinite because it is unclear what element of the invention is “with” the coupling element. Recitations such as “a drive element” on lines 7-8 of claim 4 render the claims indefinite because it is unclear if the applicant is referring to the drive rod set forth above or is attempting to set forth another element of the invention in addition to the drive rod. Recitations such as “the casement frame” on lines 8-9 of claim 4 render the claims indefinite because it is unclear if the applicant is referring to the casement frame element or the window or door casement. Recitations such as “like” on line 10 of claim 4 render the claims indefinite because it is unclear what the applicant is attempting to set forth. How much like a rod must an element be before it can be referred to as “rod like”? Recitations such as “and/or” on line 10 of claim 4 render the claims indefinite

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because it is unclear what the applicant is attempting to set forth. Is the applicant setting forth “and” only, “or” only, “and” and “or”, or “and” or “or”? Recitations such as “push/pull type” on line 10 of claim 4 render the claims indefinite because it is unclear what the applicant is attempting to set forth. What is a type of push/pull? Recitations such as “the form of” on line 2 of claim 6 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Is the coupling element actually a partial ring or arc or is the coupling element merely have the appearance of a partial ring or arc? Recitations such as “the ring axis” on line 4 and “the door casement plane” on lines 4-5 of claim 6 render the claims indefinite because they lack antecedent basis. Recitations such as “is designed as” on line 2 of claim 7 render the claims indefinite because it is unclear if the coupling element is actually a rack and pinion or merely designed to be a rack and pinion. Recitations such as “its other end” on line 2 of claim 9 render the claims indefinite because it is unclear which end the applicant is referring to since a first end has not been set forth above. Recitations such as “the circular form, namely a rectangular or square profile” on lines 3-4 of claim 12 render the claims indefinite because the applicant has presented a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim). This is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render

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a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 12 recites the broad recitation of a profile that deviates from the circular form, and the claim also recites a rectangular or square profile which is the narrower statement of the range/limitation. Recitations such as "the running shoe casing" on line 2 of claim 16 render the claims indefinite because they lack antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by German Patent No. 20 65 972. German Patent No. 20 65 972 discloses a fitting for lift-slide doors or windows with at least one forend rail 26 and one push rod 24 that can be moved axially on the forend rail and can be fastened in the area of a groove (not numbered, but shown in figure 1) on a casement frame element 11 of the door or window, wherein the forend rail is flat or strip-shaped, and whereby a width of the forend rail is somewhat greater than the width of the drive rod as shown in figure 1, and

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whereby the forend rail forms edge areas (not numbered but shown in figure 1) for bearing against contact surfaces which are formed by recesses on sides of the groove on a casement frame element, a running shoe 12, a coupling element 15, the coupling element has the form of a partial arc since it has a curved surface as shown in figure 1 adjacent the pin 21, a jointed connection 18, a coupling opening (not numbered, but comprising the space between the plates of the running shoe 12), an arc-shaped guide (not numbered, but comprising the arc-shaped element which supports the pin 17), two rollers 17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 8-10, 12-16, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent No. 20 65 972, as applied to claim 3 above, and further in view of European Patent Publication No. 1 298 271. German Patent No. 20 65 972 is silent concerning a bearing element.

However, European Patent Publication No. 1 298 271 discloses a bearing element 6, the bearing element includes at least one projection 14' forming a guide for the running shoe 10 and a guide bolt 15.

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It would have been obvious to one of ordinary skill in the art to provide German Patent No. 20 65 972 with a bearing element, as taught by European Patent Publication No. 1 298 271, to increase the ease with which the fitting can be mounted to the casement.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent No. 20 65 972 in view of European Patent Publication No. 1 298 271, as applied to claims 4-6, 8-10, 12-16, and 18-22 above, and further in view of Haws.

Haws discloses the use of a rack and pinion connection between a coupling element 56 and a drive element 58.

It would have been obvious to one of ordinary skill in the art to provide German Patent No. 20 65 972, as modified above, with a rack and pinion connection, as taught by Haws, to increase the ease with which the components of the connection can be repaired or replaced.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent No. 20 65 972 in view of European Patent Publication No. 1 298 271, as applied to claims 4-6, 8-10, 12-16, and 18-22 above, and further in view of Geiger. Geiger discloses a coupling element 33 comprising metal, as shown by the cross sectional shading in figure 3.

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It would have been obvious to one of ordinary skill in the art to provide German Patent No. 20 65 972, as modified above, with a metal construction, as taught by Geiger, to increase the strength of the fitting.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent No. 20 65 972 in view of European Patent Publication No. 1 298 271, as applied to claims 4-6, 8-10, 12-16, and 18-22 above, and further in view of Dallaire. Dallaire discloses a running shoe casing 19 having an end wall 26.

It would have been obvious to one of ordinary skill in the art to provide German Patent No. 20 65 972, as modified above, with end walls, as taught by Dallaire, to increase the strength of the running shoe casing.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McIntosh, Oleksiw, Offterdinger, Olander, European Patent Publication No. 1 298 272, German Patent Nos. 24 28 592 and 2 261 433, French Patent No. 2 514 062, and European Patent Publication No. 0 005 764 are cited for disclosing an operating mechanism for lifting the rollers of a sliding closure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a stylized flourish at the end.

Gregory J. Strimbu
Primary Examiner
Art Unit 3634
May 9, 2006